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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,203	10/02/2000	Cornelius Borst	P-3875.09	3753
27581	7590	03/09/2005	EXAMINER	
MEDTRONIC, INC. 710 MEDTRONIC PARKWAY NE MS-LC340 MINNEAPOLIS, MN 55432-5604			NASSER, ROBERT L	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/678,203		BORST ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Robert L. Nasser		3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Claims 1-22, 32-48, and 51-56, and 63-68 do not find support in the parent applications, and therefore only have a priority date of 10/2/2000. Applicant pointed to figure 25 of the parent application to provide support, but figure 25 does not have a spreader on a distal end of an arm and an actuator on a proximal end, as claims in the claims enumerated above.

Claims 23-31 and 57-62 find support in all of the parent applications, except for 08/531363, which is now US Patent 6836311. As such, claims 23-31 and 57-62 have an effective filing date of 10/3/1996.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6, 8-18, 22, and 50-56 are rejected under 35 U.S.C. 102(b) as being anticipated by Vierra et al 5,749,892. Vierra et al shows a device having an arm 43, and a mechanical actuator, knob 69, connected to one end of the arm, a spreader 51 connected to the other end of the arm and to the actuator. There are two contact members 15 and 17 connected to the spreader, which engage heart tissue via friction. Since the knob incrementally spreads the members 15-17, there are many positions between completely shut and completely open. In addition, the first position is completely closed and the second and third positions are obtained by incremental rotations of the actuator knob, 69. As such, the members 15 and 17 are substantially parallel in the first and second and third positions. The actuator knob is controlled by

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the clinician. With respect to claim 3, when inserted into the body, the members 15 and 17 are in the configuration shown in figure 3A. Hence, when they move, they move apart in a substantially parallel method. With respect to claim 11, the first position is spaced apart by less than 15 mm. The arm is fixable to a trocar or to an operating table (see column 12, lines 34-50). With respect to claim 18, since the coupling surface is friction, Vierra anticipates claim 18, as it need not show the suction features. Claim 22 is rejected for the reasons given above. Claims 50 and 53 are rejected in that the inner surface of members 15 and 17 is capable of engaging tissue. Hence, it is adapted to engage tissue. The examiner notes that adapted to contact tissue is an intended use limitation and the inner surface of the members 15 and 17 are capable of the intended use. Claims 51 and 54 are rejected in that there is a suction lumen open to the atmosphere through ports 73 in the contact surface. Claims 52 and 55 are rejected in that the contact surface is adapted to couple the members to the tissue.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vierra et al in view of Furnish 5,498,256. Furnish shows a hand lever actuator for forceps. Hence, it would have been obvious to modify Vierra to use the actuator of Furnish, as it is merely the substitution of one known equivalent actuator for another.

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Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vierra et al in view of Garrison et al 5613937. In column 15, lines 40-60, Garrison teaches the equivalence of the rotating knob actuator of Vierra and the slide actuator recited in the claims. Hence, it would have been obvious to modify Vierra to use the actuator of Garrison, as it is merely the substitution of one known equivalent actuator for another.

Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vierra et al in view of Hossain et al 6063021. Hossain et al shows an identical device to Vierra that has a variable joint 40 controllable by knob 42. Such a joint allows better conformance of the device to the heart. Hence, it would have been obvious to modify Vierra et al to use such a joint, to allow a better fit onto the surface of the heart.

Claims 23-26, 28, 30-35, 37, 39-50, and 57-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vierra et al in view of Benetti et al 5894843. In addition to the features of Vierra discussed above, Benetti shows a stabilizer for a similar purpose where the feet 1 are parallel. Since the devices in Benetti and Vierra perform substantially the same function, they are functional equivalents. As such, it would have been obvious to modify Vierra to use parallel feet rather than V shaped feet, as it is merely the substitution of on known configuration for another. Again, since the feet 15 and 17 of Vierra are positioned incrementally using the rotational knob, the combination would have a plurality of positions as well. The remaining claim features are discussed above. With respect to the method claims, the examiner notes that in Vierra, the members are introduced in the first closed position, then expanded to the open position and then contacted to the heart.

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Claim 27 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vierra et al in view of Benetti, as applied to claims 23-26, 28, 30-35, 37, 39-50, and 57-68, further in view of Furnish 5,498,256. Furnish shows a hand lever actuator for forceps. Hence, it would have been obvious to modify Vierra to use the actuator of Furnish, as it is merely the substitution of one known equivalent actuator for another.

Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vierra et al in view of Benetti, as applied to claims 23-26, 28, 30-35, 37, 39-50, and 57-68, further in view of Garrison et al 5613937. In column 15, lines 40-60, Garrison teaches the equivalence of the rotating knob actuator of Vierra and the slide actuator recited in the claims. Hence, it would have been obvious to modify Vierra to use the actuator of Garrison, as it is merely the substitution of one known equivalent actuator for another.

Applicant's arguments filed 12/13/2004 have been considered, but are not deemed to be persuasive.

Applicant has argued that Vierra only has two positions open and closed. The examiner disagrees, noting that in column 7, lines 44-49, Vierra teaches using an actuator for providing a selective amount of spreading. Knob 69 is this actuator.

Applicant has also asserted that Vierra does not teach a second parallel position other than the first position. The examiner notes that claim 1 only requires that the positions be substantially parallel and the examiner feels that this limitation is met by Vierra, as discussed above.

Again, with respect to claim 22, it is the examiner's position that a selective amount of "substantially parallel spreading occurs.

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Applicant has further asserted that Vierra and Furnish, Garrison, or Hossain fail to provide motivation for the respective combinations. The examiner disagrees, noting that the secondary references each teach alternate methods of actuating 2 jaws and therefore are combinable.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser whose telephone number is (571) 272-4731. The examiner can normally be reached on Mon-Fri, variable hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert L. Nasser  
Primary Examiner  
Art Unit 3736

RLN  
March 4, 2005

*Robert L. Nasser*  
[Stamp]